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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,122	11/14/2001	Mike Dennis	OAE 306	5951

23855 7590 06/03/2003

ROBERT D. VARITZ, P.C.
2007 S.E. GRANT STREET
PORTLAND, OR 97214

EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

6L

Office Action Summary

Application No.

10/003,122

Applicant(s)

DENNIS ET AL.

Examiner

Ted Kavanaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> | 6) <input type="checkbox"/> Other: |

Specification

1. The disclosure is objected to because of the following informalities: On page 3, line 1 and page 4, line 7, applicant refers to attaching documents. If the application becomes a patent the attached documents will not be printed. Therefore, it is suggested applicant delete the reference (i.e. (see attached document A) to these and list them on a PTO-1449.

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required (Note: anything that is new matter can not be corrected):

The following limitations do not have support in original disclosure and also appears to be new matter (see the new matter rejection below) and therefore will not be permitted in the specification. In claim 4, the phrase "elongate load-distributing fibres joined load-transmissively to said cushioning layer" lacks support. The elongate fibres 14a are not taught to be joined to said cushioning layer 12. These fibres 14a are not on the outside of the fabric-overlayer 14 and therefore can't be joined to the cushioning layer. See figure 1 and 2, which show the fibres 14a with dashed-lines. In claim 4, "a moisture-wicking characteristic which collects moisture, and, via contact between said two layers, furnishes such collected moisture to said cushioning layer's said upper surface" lacks support. It has been stated numerous times throughout the specification that the moisture is wicked towards the side edges (perimeter) of the insole, see pg. 4, lines 17-20, pg. 6, lines 4-7 and 17-19. There is no teaching of the moisture collecting

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on the upper surface of the cushioning layer's upper surface. In claim 5, lines 5-8, the phrase "the cooperative layer combination which utilizes lateral load distribution and moisture wicking as companion contributions in the retardation of the time to reach peak, experienced G-force following occurrence of a shock impact" lacks support in the specification. Moreover this appears to be new matter. The load distribution and the moisture wicking have been taught separate but not together and not as a contribution in the retardation of the time to reach peak, experienced G-force following occurrence of a shock impact. This appears to be linked to the elongate fibres 14a being joined to the cushioning layer 12, which, as noted above is new matter. Lines 2-4 of claim 6 are similarly lacking support in the specification and are also new matter. In claim 5, the phrase "fabric overlayer **joined in a load-coupling manner** to the upper surface of said lower layer" lacks support in the specification. Moreover, this appears to be new matter. The specification and the drawings show layers 14 and 12 joined together but there is no teaching that they are "joined in a load-coupling manner". Claim 6, lines 7-8 are similarly lacking support in the specification and are new matter. In claim 5, "load-distributing fibres which cause ... and load-telegraphing to occur to laterally spaced regions of said lower layer in response to...on the upper side of the insole structure" lacks support in specification. Moreover, it is new matter. The fibres 14a are not joined to the upper surface of the cushioning layer 12 and are not taught to load-telegraph to the upper surface of the cushioning layer 12 as now claimed. There is no support for the last paragraph of claims 5 and 6. Moreover, it is new matter. This is similar to lines

5-8 of claim 5. Claim 6, lines 8-11 similarly lack support in the specification and are new matter.

Claim Rejections - 35 USC § 112

3. Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 4, the phrase “elongate load-distributing fibres joined load-transmissively to said cushioning layer” is new matter. The elongate fibres 14a are not taught to be joined to said cushioning layer 12. These fibres 14a are not on the outside of the fabric-overlayer 14 and therefore can't be joined to the cushioning layer. See figure 1 and 2, which show the fibres 14a with dashed-lines. In claim 4, “a moisture-wicking characteristic which collects moisture, and, via contact between said two layers, furnishes such collected moisture to said cushioning layer's said upper surface” is new matter. It has been stated numerous times throughout the specification that the moisture is wicked towards the side edges (perimeter) of the insole, see pg. 4, lines 17-20, pg. 6, lines 4-7 and 17-19. There is no teaching of the moisture collecting on the upper surface of the cushioning layer's upper surface. In claim 5, lines 5-8, the phrase “the cooperative layer combination which utilizes lateral load distribution and moisture wicking as companion contributions in the retardation of the time to reach peak, experienced G-force following occurrence of a shock impact” appears to be new matter.

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The load distribution and the moisture wicking have been taught separate but not together and not as a contribution in the retardation of the time to reach peak, experienced G-force following occurrence of a shock impact. This appears to be linked to the elongate fibres 14a being joined to the cushioning layer 12, which, as noted above is new matter. Lines 2-4 of claim 6 are similarly lacking support in the specification and are also new matter. In claim 5, the phrase "fabric overlayer joined in a load-coupling manner to the upper surface of said lower layer" appears to be new matter. The specification and the drawings show layers 14 and 12 joined together but there is no teaching that they are "joined in a load-coupling manner". Claim 6, lines 7-8 are similarly new matter. In claim 5, "load-distributing fibres which cause ... and load-telegraphing to occur to laterally spaced regions of said lower layer in response to...on the upper side of the insole structure" is new matter. The fibres 14a are not joined to the upper surface of the cushioning layer 12 and are not taught to load-telegraph to the upper surface of the cushioning layer 12 as now claimed. There is no support for the last paragraph of claims 5 and 6. Moreover, it is new matter. This is similar to lines 5-8 of claim 5. Claim 6, lines 8-11 similarly is new matter.

In summary, it would appear from applicant's remarks that the crux of his invention is the combined structure of the layers 12 and 14 joined together by a load coupling manner and/or the elongated fibres joined load transmissively to the upper surface of the cushioning layer 12. And it is this structure that creates a situation wherein moisture is wicked and made available and drawn into the structure of layer 12 dramatically enhances the layer's ability to extend/retard the time between occurrence

of a shock event and the occurrence of peak G-force acceleration/deceleration, see the top of page 11 of applicant's remarks in the amendment filed 2-18-03. However, these structural limitations are new matter and the resulting function is new matter based upon the lack of support of these limitations.

Response to Arguments

4. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

The examiner was unable to apply an art rejection to the claims in view of the newly added limitations. Although these limitations are new matter and therefore haven't been searched for. It would appear from applicant's remarks and newly added limitation that his invention has evolved slightly, therefore it is suggested that applicant file a continuation-in-part.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (FORMAL FAXES ONLY). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

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Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
June 2, 2003